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| 09/214,971 | 01/15/1999 | GABRIELE VALENTE | 30966.13USWO | 7959 |

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GREENBERG TRAURIG LLP
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| EXAMINER |
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CHEVALIER, ALICIA ANN

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| ART UNIT | PAPER NUMBER |
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1772

DATE MAILED: 12/03/2003

32

Please find below and/or attached an Office communication concerning this application or proceeding.

cc032

Office Action Summary

Application No.

09/214,971

Applicant(s)

VALENTE, GABRIELE

Examiner

Alicia Chevalier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8,9,13,14,18,19 and 24-56 is/are pending in the application.
- 4a) Of the above claim(s) 37-56 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8,9,13,14,18,19 and 24-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☒ Interview Summary (PTO-413) Paper No(s). 30.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

RESPONSE TO AMENDMENT

Election/Restrictions

1. Newly submitted claims 37-56 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:
2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 8, 9, 13, 14, 18, 19, and 24-36, drawn to method of using a composite material, classified in class 428, subclass 131.
 - II. Claims 37-50, drawn to a method of forming a composite, classified in class 156, subclass various.
 - III. Claims 52-56, drawn to a composite material, classified in class 428, subclass various.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 37-56 withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Furthermore, Applicant has already been issued a restriction requirement in paper #13 (*mailed April 4, 2001*) and have elected to prosecute the invention of Group I, the method of using the composite, in paper #14 (*filed June 6, 2001*).

REJECTIONS

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 8, 13, 18, 31, 32 and 33 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In the instant case claims 8, 13, 18, 31, 32 and 33 previously added "reconstructed leather" to replace "regenerated leather," see paper #26 filed March 12, 2003. There is no support in the specification for this switch.

6. Claims 13 and 32 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 13 and 32 both contain the previously added the limitation "there being no foam between the supporting materials and film." The specification does not disclose that a foam layer is specifically excluded from being between the supporting material and the film, therefore this limitation is considered new matter.

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Any negative limitation or exclusionary proviso must have basis in the original disclosure. See *Ex parte Grasselli*, 231 USPQ 393 (Bd. App. 1983), aff'd mem., 738 F.2d 453 (Fed. Cir. 1984). The mere absence of a positive recitation is not basis for an exclusion. Any claim containing a negative limitation which does not have basis in the original disclosure should be rejected under 35 U.S.C. 112, first paragraph as failing to comply with the written description requirement. MPEP § 2173.05(i)

Claim Rejections - 35 USC § 103

7. Claims 8, 9, 13, 14, 18, 19, 24, 26, 27 and 31-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parker et al. (3,505,169) in view of Irion et al. (2,714,571) and Holtzman (3,866,554) or Lockwood (3,641,603).

Regarding claims 8, 9 and 31, Parker discloses a synthetic leather composite material comprising only two layers; a supporting material sheet of a mixture of a reconstructed leather material and an optional coating film (*col. 6, lines 31-45*). Regarding claims 13, 14 and 32, there is no foam between the supporting material and film (*col. 6, lines 31-45*). Regarding claims 18, 19 and 33, the supporting material is directly coupled to the film (*col. 6, lines 31-45*).

Parker fails to disclose the coating film being an embossed polyethylene film and steps for forming the material into a shape to produce one of the claimed products.

However, Irion teaches a synthetic leather composite material comprising a fibrous web and an embossed polyethylene film (*col. 1, lines 51-63*). Irion recognizes that polyethylene is well recognized as a protective coating material. It is tough, extensible, and abrasive resistant, it has a high tear strength, it is odorless, tasteless, and non-toxic, it can be formed or shaped by thermal means without additives and has a low specific gravity so that a given thickness will cover a relatively large area per pound (*col. 1, lines 11-21*). Furthermore, because polyethylene may be easily and cheaply embossed and may be colored with pigments or dyes, the composite is

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good for manufacturing very inexpensive and sturdy artificial leathers, furniture and surfacing, luggage coverings and similar materials (*col. 1, lines 51-63*).

Holtzman discloses using a synthetic leather material for use as luggage (suitcase elements) including the step of forming the material into a shape to produce the luggage. The steps of forming the luggage includes the step of cutting the composite materials to form the product. *See the summary of the invention, col. 1, line 53 to col. 2, line 42.*

Lockwood discloses using an artificial leather material for use in as a shoe vamp including the step of forming the material into a shape to produce the shoe vamp. The steps of forming the shoe vamp includes the step of cutting the composite materials to form the product. *See column 1, lines 11-28 and example 1.*

It would have been obvious to one of ordinary skill in the art at the time of the invention to use the protective embossed polyethylene film of Irion as the optional coating film in Parker because of the improved protective properties of Irion's embossed polyethylene film such as toughness, extensibility, abrasive resistance, high tear strength, and it can be formed or shaped by thermal means without additives. Furthermore, it would have been obvious to one of ordinary skill in the art at the time of the invention to use the synthetic leather composite of Parker and Irion as the synthetic/artificial leather of Holtzman or Lockwood because of the good properties of Parker and Irion to have good properties of natural leather and have improved protective properties such as toughness, extensibility, abrasive resistance, and high tear strength.

Regarding claims 24, 26 and 27, the method of forming the product is not germane to the issue of patentability of the method of using the product or the product itself. The determination of patentability for a method of using a product claim is based on the product itself and the

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method of using the product and not on the method of production, MPEP §2113. In this case, the limitations in claim 24 "including coal bonding the film layer, the film layer not being extruded directly onto the leather," claim 26 "including hot bonding the film layer, the film layer not being extruded directly onto the leather" and claim 27 "effecting the embossing on the film layer during the bonding" are methods of production and therefore does not determine the patentability of the product itself or the method of using the product.

8. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Parker et al. (3,505,169) in view of Irion et al. (2,714,571) and Holtzman (3,866,554) or Lockwood (3,641,603) as applied to claims 8, 9, 13, 14, 18, 19, 24, 26, 27 and 31-33 above, and further in view of Shirota et al. (3,652,747).

Parker, Irion, Holtzman and Lockwood are relied upon as described above.

None of references disclose an adhesive between the film and the leather.

However, Shirota teaches a synthetic leather composite comprising a base cloth, a foam layer and a synthetic high molecular weight coating wherein the layers are bonded together using adhesive (*col. 1, lines 24-38 and col. 11, lines 48-56*).

It would have been obvious to one of ordinary skill in the art at the time of the invention to use adhesive as taught by Shirota to bond the layers of Parker and Irion because they are solving a similar problem, making synthetic leather by bonding multiply layers together to form a composite. One would be motivated to use adhesive between the layer of Parker and Irion's composite because the adhesive would insure a strong bond.

9. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Parker et al. (3,505,169) in view of Irion et al. (2,714,571) and Holtzman (3,866,554) or Lockwood

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(3,641,603) as applied to claims 8, 9, 13, 14, 18, 19, 24, 26, 27 and 31-33 above, and further in view of Nishimure et al. (3,958,057).

Parker, Irion, Holtzman and Lockwood are relied upon as described above.

None of references disclose a dyestuff layer between the film and the leather.

However, Nishimure discloses a leather-like sheet comprising a pearl substrate layer, a colored layer, and a clear enameled porous sheet (*col. 3, line 54 to col. 4, line 30*). Where the colored layer is a dyestuff layer (*col. 4, lines 5-14*). The leather-like sheet material exhibits the ability to easily perform color matching (*col. 2, lines 1-9*).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to add a dyestuff layer as taught by Nishimure between the reconstructed leather layer and the film layer of the combination of Parker and Irion. One would be motivated to do so in order enhance or change the color of the layer as desired for its intended use in order to have the ability to easily perform color matching.

10. Claims 29 and 34-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parker et al. (3,505,169) in view of Irion et al. (2,714,571) and Holtzman (3,866,554) or Lockwood (3,641,603) as applied to claims 8, 9, 13, 14, 18, 19, 24, 26, 27 and 31-33 above, and further in view of Hara (JP 404130172 A).

Parker, Irion, Holtzman and Lockwood are relied upon as described above.

None of references disclose adding a leather scent.

However, Hara discloses a leather coat film with a leather perfume layer for better simulation of real leather (*Derwent abstract*).

It would have been obvious to one of ordinary skill in the art to add the leather perfume layer of Hara to the composite material of Parker and Irion. One would be motivated to add the leather perfume to the composite material of Parker and Irion in order to enhance the simulation of real leather.

11. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Parker et al. (3,505,169) in view of Irion et al. (2,714,571) and Holtzman (3,866,554) or Lockwood (3,641,603) as applied to claims 8, 9, 13, 14, 18, 19, 24, 26, 27 and 31-33 above, and further in view of ROHM SND HASS COMPANY (GB 1,514,224).

Parker, Irion, Holtzman and Lockwood are relied upon as described above.

None of references disclose adding a series of perforations in the composite material.

However, Rohm discloses a composite material that simulates leather (*page 1, lines 23-27*). The film can be made breathable by mechanically puncturing (perforations) the film (*page 5, lines 56-58*).

It would have been obvious to one of ordinary skill in the art at the time of the invention to add perforations as taught by Rohm to the composite of Parker and Irion. One of ordinary skill in the art would have been motivated to add perforation to the composite of Parker and Irion to increase the breathability of the composite.

ANSWERS TO APPLICANT'S ARGUMENTS

12. Applicant's arguments filed in paper #29 (*filed August 5, 2003*) regarding the combination of Parker et al. (3,505,169) in view of Irion et al. (2,714,571) have been carefully considered but are deemed unpersuasive.

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Applicant argues that there is no motivation, teaching or suggestion in the prior art for applying polyethylene to reconstructed or natural leather.

Parker discloses making a *synthetic leather*/leather substitute that has all of the good properties of natural leather, using reconstituted leather (*col. 1, lines 26-52*). Applicant continually argues that reconstructed leather is a natural leather product. This is not true, only leather is a natural product. As pointed out in Applicant's response reconstituted leather as defined by Parker, scraps of leather in a polymer matrix with other additives, which is not a natural product. ***Reconstituted leather is a synthetic material.*** The examiner's conclusion that reconstituted leather is a synthetic material has support in the Parker reference because Parker is making a synthetic leather (*col. 1, line 50 and col. 6, lines 37-38*). Applicant's specification does not have support to contradict the Parker's definition of reconstituted leather.

The Examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. *In re Nomiya*, 184 USPQ 607 (CCPA 197). However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. *In re McLaughlin*, 170 USPQ (CCPA 1971). References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. *In re Bozek*, 163 USPQ 545 (CCPA) 1969.

In this case, both Parker and Irion are solving a similar problem, i.e. trying to improve synthetic leather/leather substitute. Furthermore, Irion recognizes improved properties for synthetic leathers by using a coating of embossed polyethylene, such as, toughness, extensibility,

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abrasive resistance, and high tear strength. Since Parker discloses the use of a coating material in order to give the surface of the *synthetic leather* a more pleasant appearance (Parker col. 6, lines 31-38), one of ordinary skill in the art would have recognized the additional benefits gained from Irion's protective embossed polyethylene film when used in synthetic leather and therefore would have been motivated to combine Parker and Irion.

13. Applicant's arguments filed in paper #29 regarding the argument that before the invention it was counterintuitive to coat the natural product with polyethylene have been carefully considered but are deemed unpersuasive.

As discussed above, *reconstituted leather is a synthetic material*, as defined by Parker. Since, Applicant's specification does not have support to contradict Parker's definition of reconstituted leather, Applicant's argument is only found persuasive for natural leather. However, since the limitation in the claim recites the use of reconstituted or natural leather in the alternative, the use of natural leather is optional and therefore the limitations of the claims have been met by the above rejections.

Applicant's further arguments regarding the claimed invention and rejections revolve around reconstituted leather being a natural product, which has already been addressed.

14. Applicant's arguments filed in paper #29 regarding Commercial Success Declaration in paper #22.5 (*filed December 24, 2003*) have been carefully considered but are deemed unpersuasive.

The Commercial Success Declaration is not deemed to be persuasive for the following reasons:

1. There is no showing of the market share.

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Gross sales figures do not show commercial success absent evidence as to market share, *Cable Electric Products, Inc. v. Genmark, Inc.*, 770 F.2d 1015, 226 USPQ 881 (Fed. Cir. 1985), or as to the time period during which the product was sold, or as to what sales would normally be expected in the market, *Ex parte Standish*, 10 USPQ2d 1454 (Bd. Pat. App. & Inter. 1988). MPEP § 716.03

2. The declaration is not objective evidence. Specifically, the declaration was written by

Applicant and shows a “potential” economic advantage.

Objective evidence of nonobviousness including commercial success must be commensurate in scope with the claims. *In re Tiffin*, 448 F.2d 791, 171 USPQ 294 (CCPA 1971). MPEP § 716.03

Other relevant citations from MPEP § 716.03:

An affidavit or declaration attributing commercial success to a product or process “constructed according to the disclosure and claims of [the] patent application” or other equivalent language does not establish a nexus between the claimed invention and the commercial success because there is no evidence that the product or process which has been sold corresponds to the claimed invention, or that whatever commercial success may have occurred is attributable to the product or process defined by the claims. *Ex parte Standish*, 10 USPQ2d 1454, 1458 (Bd. Pat. App. & Inter. 1988).

In *ex parte* proceedings before the Patent and Trademark Office, an applicant must show that the claimed features were responsible for the commercial success of an article if the evidence of nonobviousness is to be accorded substantial weight. See *In re Huang*, 100 F.3d 135, 140, 40 USPQ2d 1685, 1690 (Fed. Cir. 1996) (Inventor’s opinion as to the purchaser’s reason for buying the product is insufficient to demonstrate a nexus between the sales and the claimed invention.). Merely showing that there was commercial success of an article which embodied the invention is not sufficient. *Ex parte Remark*, 15 USPQ2d 1498, 1502-02 (Bd. Pat. App. & Inter. 1990). *Compare Demaco Corp. v. F. Von Langsdorff Licensing Ltd.*, 851 F.2d 1387, 7 USPQ2d 1222 (Fed. Cir. 1988) (In civil litigation, a patentee does not have to prove that the commercial success is not due to other factors. “A requirement for proof of the negative of all imaginable contributing factors would be unfairly burdensome, and contrary to the ordinary rules of evidence.”).

Conclusion

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Chevalier whose telephone number is (703) 305-1139.

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The Examiner can normally be reached on Monday through Thursday from 8:00 a.m. to 5:00 p.m. The Examiner can also be reached on alternate Fridays


If attempts to reach the Examiner are unsuccessful, the Examiner's supervisor, Harold Pyon can be reached by dialing (703) 308-4251. The fax phone number for the organization official non-final papers is (703) 872-9306. The fax number for after final papers is (703) 872-9311.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose phone number is (703) 308-0661.

ac

11/26/03

A large, stylized handwritten signature, possibly reading 'A.K.', is written in black ink.


HAROLD PYON
SUPERVISORY PATENT EXAMINER
1772

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~~11/31~~